IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Ho Kee Herbert Law et al.
Serial No.:	10/824,243
Filed:	April 14, 2004
Title:	Combined Joy Pad and Joystick Controller
Art Unit:	2629
Confirmation No.:	6425
Examiner:	Rodney Amadiz
Docket No.:	50T5479.01

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Sir:

Appellant hereby petitions the Assistant Commissioner to grant an extension of time, up to and including Monday, July 21, 2008, in which to file this Appeal Brief. The extension fee may be charged to deposit account No. 50-1047. In addition, any deficiencies may be charged to deposit account No. 50-1047.

As set forth in the Notice of Appeal filed February 19, 2008, Appellant hereby appeals the final decision of the Examiner in the above-identified application rejecting the subject matter of the pending claims. Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's rejection of the claimed subject matter.

I. REAL PARTY IN INTEREST

Sony Corporation is the assignee of the present invention and the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellant, Appellant's legal representative, or the assignees, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

This application was filed with Claims 1-27.

A first Office Action mailed on January 9, 2007 rejected all of Claims 1-27. Specifically, Claims 1-5, 7, 8, 18-23 and 27 were rejected under 35 USC 102(e) as being anticipated by Mak (USPGPUB 2004/0085289); Claim 1 was rejected under 35 USC 102(e) as being anticipated by Fleck et al. (US Patent 6,977,811); Claims 6, 9 and 12-16 were rejected under 35 USC 103(a) as being unpatentable over Mak in view of Motoki et al. (US Patent 6,752,758); Claims 10, 11, 17, 24 and 25 were rejected as being unpatentable over Mak and Motoki in view of Fleck; and Claim 26 was rejected as being unpatentable over Mak in view of Harding et al. (US Patent 6,184,869).

An Amendment in response to the 1/9/07 Office Action was filed on June 3, 2007. Claims 1, 10, 12, 18 and 25 were amended and Claims 6, 17, 24 and 27 were canceled.

A second, Final Office Action was mailed on August 17, 2007. Claims 1-5 and 7-9 were rejected under 35 USC 103(a) as being unpatentable over by Mak (USPGPUB 2004/0085289) in view of Motoki et al. (US Patent 6,752,758); Claims 10-16, 18-23 and 25 were rejected under 35 USC 103(a) as being unpatentable over Mak and Motoki in view of Fleck et al. (US Patent 6,977,811); and Claim 26 was rejected under 35 USC 103(a) as being unpatentable over as being unpatentable over Mak in view of Motoki, Fleck and Harding et al. (US Patent 6,184,869).

A Notice of Appeal was filed on February 19, 2008.

An Amendment After Final Rejection, canceling Claims 1-5 and 7-9, is filed herewith.

Claims 10-16, 18-23, 25 and 26 are pending and stand finally rejected. Claims 10, 12 and 18 are the only independent claims. The rejection of each of the pending claims is appealed. The pending claims are set for in the Claims Appendix in Section VIII of this Brief.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed on August 17, 2007, finally rejecting Claims 1-5, 7-16, 18-23, 25 and 26. A Notice of Appeal was filed on February 19, 2008. An Amendment After Final Rejection, canceling Claims 1-5 and 7-9, is filed herewith.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The application recites in CLAIM 10, an apparatus for interfacing with a user including a first manipulandum to provide a first type of input from the user to a computer program, wherein the first manipulandum comprises a joystick and wherein the joystick includes a circular top, and a second manipulandum disposed in close proximity to the first manipulandum to provide a second type of input from the user to the computer program, wherein the second manipulandum comprises a joy pad (paragraph [0025] (page 6, lines 12-18); Figs. 1, 2, 7, 8). The joy pad includes one or more inputs, and the circular top has a radius that extends almost to a beginning of the one or more inputs of the joy pad, whereby a user can simultaneously move the joy stick and depress one input of the joy pad with a single digit (paragraph [0024] (page, 6, lines 5-6), paragraph [0028] (page 7, lines 4-7), paragraph [0029] (page 7, lines 14-23, paragraph [0030] (page 8, lines 1-5), Figs. 6-8).

CLAIM 12 is directed to an apparatus for interacting with a computer, including a multifunction switch including a plurality of buttons to accept one or more discrete inputs from the user and a joystick input device disposed in close proximity to the multifunction switch to accept continuous input from the user (paragraph [0025] (page 6, lines 12-18); Figs. 1, 2, 7, 8). The joystick includes a knob disposed on a top of the joystick, the knob having a circular top and extending in radius to the plurality of discrete inputs (paragraph [0029] (page 7, lines 17- 20), Fig. 6).

CLAIM 18 is directed to a method for interfacing a user and a computer program including coupling a joystick to a computer interface to provide first input from a user to a computer program executing on a computer, coupling a joy pad to a computer interface to provide second input from a user to the computer program executing on the computer, and disposing the joystick in close proximity to the joy pad so that a single user's digit can manipulate both the joystick and one or more buttons or positions on the joy pad (paragraph [0025] (page 6, lines 12-18); Figs. 1, 2, 7, 8). The joystick includes a knob disposed on a top of the joystick, the knob having a circular top and extending in radius to the plurality of directional inputs (paragraph [0029] (page 7, lines 17- 20), Fig. 6).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant presents the following issue for review:

(A) Would the subject matter of appealed Claims 10-16, 18-23, 25 and 26 have been obvious and unpatentable under 35 USC 103(a) to one of ordinary skill in the art at the time the invention was made from the combined disclosures of over Mak (USPGPUB 2004/0085289) and Motoki (US Patent 6,752,758) in view of Fleck (US Patent 6,977,811).

VII. ARGUMENT

Appellant respectfully submits that the rejection of Claims 10-16, 18-23, 25 and 26 (Claims 10, 12 and 18 are independent) is erroneous for the following reasons.

The first Office Action took the position (para 5) that "Mak fails to teach the first type of input comprising *continuous* input", but "it would be obvious...to incorporate the use of an analog joystick as taught by Motoki in the input device taught by Mak in order to provide the device with a greater degree of freedom to function". Applicants respectfully disagree.

First, Motoki is directed to an endoscope apparatus with a "bending drive device with a drive source" for bending a bending portion of the endoscope – Motoki is focused on improving operational precision of an endoscope, noting that "the operational precision is improved by narrowing an insensitive range of a neutral position where an angle signal form a joystick should be stopped" (col. 5, lines 34-37). Motoki includes only one "manipulandum". Motoki is directed to completely nonanalogous art of an endoscope drive device, and there is absolutely no reason to believe that Motoki would have come to Mak's attention in considering a way to "provide his device with a greater degree of freedom to function" as alleged in the Action.

In the Final Action, the Examiner responded to Applicant's argument stating that Mak and Motoki are analogous is that they both "teach the use of joysticks as input devices".

In response, Applicants again respectfully submit that one of ordinary skill in the art would have absolutely no motivation (i.e., no apparent reason) to turn to the alleged teachings of the Motoki *endoscope apparatus patent* to attempt to combine any teachings therein with Mak. The assertion in the Office Action that such a combination would "provide the device with a greater degree of freedom to function" relies solely upon Applicants' very own teachings as the device of Mak is operable *without* any modification including a "first type of input comprising *continuous* input" and provides no indication of a desire to examine all joystick teachings for a "greater degree of freedom to function" (that would allegedly lead to the proposed combination).

For at least the foregoing reasons, each of independent Claims 10, 12 and 18 is believed patentable over the combined teachings of Mak and Motoki.

Independent Claim 10 further includes the recitation of the limitation that the joy pad includes one or more inputs, and the *circular top has a radius that extends almost to a beginning of the one or more inputs of the joy pad*, whereby a user can move the joy stick and *simultaneously* depress one input of the joy pad with a single digit.

Independent Claim 12 is directed to an apparatus for interacting with a computer, the apparatus having a multifunction switch including a plurality of buttons to accept one or more discrete inputs from the user and a joystick input device disposed in close proximity to the multifunction switch to accept continuous input from the user. The joystick includes a knob disposed on a top of the joystick, the knob having a circular top and *extending in radius to the plurality of discrete inputs*.

Independent Claim 18, is directed to a method for interfacing a user and a computer program including coupling a joystick to a computer interface to provide first input from a user to a computer program executing on a computer, coupling a joy pad to a computer interface to provide second input from a user to the computer program executing on the computer and disposing the joystick in close proximity to the joy pad so that a single user's digit can manipulate both the joystick and one or more buttons or positions on the joy pad. The joystick includes a knob disposed on a top of the joystick, the knob having a circular top and *extending in radius to the plurality of directional inputs*.

Claims 10, 12 and 18 were rejected based upon the alleged combined teachings of Mak, Motoki and Fleck. Specifically, the Action (para. 3) alleges "Mak teaches the joy pad including one or more inputs", "Motoki teaches the joystick knob with a circular top" – "Mak and Motoki fail to teach the circular top having a radius that *extends almost* to a beginning of the one or more inputs of the joy pad, whereby a user can *simultaneously move the joy stick and depress the one input of the joy pad with a single digit*" (emphasis added).

The Action then alleges that Fleck provides the teachings acknowledged to be missing from Mak and Motoki, and that "it would be obvious....to form an input device relatively close to a keypad as taught by Fleck in the input device taught by Mak and Motoki so that the user would not have to reposition his fingertips across the keyboard to actuate a key".

Again, Applicants submit that first, one of ordinary skill in the art would have absolutely no apparent reason to turn to the alleged teachings of the Motoki *endoscope apparatus patent* to attempt to combine any teachings therein with Mak, much less to then turn to the alleged teachings of Fleck "so that a user would not have not reposition his fingertips". The multiple statements provided in the Action to combine the alleged teachings of Mak, Motoki and Fleck in the manner proposed, rely solely upon Applicants' very own teachings.

In addition, Applicants submit that Mak, Motoki and Fleck all fail to teach or even suggest an apparatus, as defined by each of independent Claims 10, 12 and 18, for interfacing with a user, that includes a joystick with a circular top and a joy pad disposed in close proximity to the joystick, wherein the joy pad includes one or more inputs and a circular top having a radius that extends almost to a beginning of the one or more inputs of the joy pad, whereby a user can *simultaneously* move the joy stick and depress one input of the joy pad with a single digit.

Finally, Applicants submit that each of independent Claims 12 and 18 recites that the "joystick includes a knob disposed on a top of the joystick, the knob having a circular top and *extending in radius to the plurality of discrete inputs*".

Fleck merely recites that the right and left arrow buttons "can be positioned several millimeters away from the mouse button 300" which "allows the user to rest his thumb over the mouse button 300, and then actuate the right arrow button 302 or the left arrow button 304 by simply 'rocking' his thumb sideways" (col. 5, lines 13-19), but does not teach or even suggest that the mouse button "extends in radius to the plurality of discrete inputs" (this is not shown in the Figures, nor described in the detailed description of Fleck).

In response to Applicant's previous arguments over the teachings of Fleck, the Examiner states in the Final Action (page 10, lines 5-8) that "Fleck clearly shows the mouse button (Fig. 3, 300) extends in radius to the discrete inputs (302, 304, 306, 308)...[f]urthermore, Fleck teaches that the mouse button (300) is self-centering (Col. 4, lines 51-58), which clearly implies that the mouse can move towards the discrete buttons".

Applicant respectfully directs the Examiner at least to paragraphs [0029]-[0031] of Applicant's specification, as filed, and to Figs. 6-8 as filed, which show a single finger manipulating the joystick and mouse button *simultaneously*.

The mouse 300 in Fig. 3 of Fleck ***does not – in any way, extend in radius to the right and left or up and down arrow buttons (302, 304, 306, 308)***. In addition, Fleck provides absolutely no suggestion or teaching that the mouse button 300 and directional buttons 302, 304, 306, 308 can be *simultaneously manipulated* (see Claim 1 of Fleck, for example, which recites that the mouse assembly permits "a same single fingertip to actuate the mouse button OR one of the directional buttons" (the claim does not recite, nor does the specification of Fleck support, the actuation of the mouse button AND a directional button, simultaneously).

For at least the foregoing reason, Applicant respectfully submits that each of independent Claims 10, 12 and 18 is patentable over any permissible combination of teachings of Mak, Motoki and Fleck.

Dependent Claims 11, 13-16, 19-23 and 25-26 are also believed to be patentable over the art of record for at least the same reasons as indicated above with respect to Claims 10, 12, and 18, one or another from which they depend, and are believed to even further define over the art of record by reciting additional distinguishing limitations.

Of course to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to make the necessary modification of the teaching of the references combined to result in the pending claims. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. Not only is there no suggestion or motivation to combine the alleged teachings of the Mak, Motoki and Fleck references in the manner provided in the Final Action, the cited Mak, Motoki and Fleck references simply fail to even teach or suggest all of the claim limitations.

Appellant further respectfully submits that it is, of course, improper to pick and choose elements from several references in order to "build" an obviousness rejection, when such a combination would not in fact have been obvious to one of ordinary skill in the art. One of ordinary skill in the art would not have even considered turning to the alleged teachings of Motoki without the teachings provided by Appellant's disclosure – which, of course, is not a proper basis for rejection, as it is impermissible to use an Applicants' specification as an instruction manual or "road map" to piece together the teachings of the prior art in order to render claims obvious.

Accordingly, Appellants respectfully submit that independent Claims 10, 12 and 18, and dependent Claims 11, 13-16, 19-23, 25 and 26 of the present invention would not be obvious in light of any combination of the teachings of Mak, Motoki and Fleck.

CONCLUSION

The references relied upon by the Examiner do not support a *prima facie* case of obviousness. Appellant submits that the pending claims, Claims 10-16, 18-23, 25 and 26 are patentable over the art of record and it is respectfully requested that the Board reverse the final rejection of the subject matter of these claims for the reasons given above.

Respectfully submitted,

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I hereby certify that this document and any document referenced herein has been transmitted via facsimile to the US Patent and Trademark Office at (571) 273-8300 on July 21, 2008.

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(Signature)

VIII. CLAIMS APPENDIX

The claims involved in the appeal, Claims 10-16, 18-23, 25 and 26 are reproduced below.

1-9. (Canceled)

10. (Previously Presented) An apparatus for interfacing with a user comprising:

a first manipulandum to provide a first type of input from the user to a computer program, wherein the first manipulandum comprises a joystick and wherein said joystick includes a circular top; and

a second manipulandum disposed in close proximity to the first manipulandum to provide a second type of input from the user to the computer program, wherein the second manipulandum comprises a joy pad,

wherein the joy pad includes one or more inputs, and the circular top has a radius that extends almost to a beginning of the one or more inputs of the joy pad, whereby a user can simultaneously move the joy stick and depress one input of the joy pad with a single digit.

11. (Original) The apparatus according to claim 10, wherein the circular top includes a beveled edge.

12. (Previously Presented) An apparatus for interacting with a computer comprising:

a multifunction switch including a plurality of buttons to accept one or more discrete inputs from the user; and

a joystick input device disposed in close proximity to the multifunction switch to accept continuous input from the user,

wherein the joystick includes a knob disposed on a top of the joystick, said knob having a circular top and extending in radius to the plurality of discrete inputs.

13. (Original) The apparatus according to claim 12, wherein the joystick is disposed in a center of the multifunction switch.

14. (Original) The apparatus according to claim 12, wherein the multifunction switch includes a plurality of discrete inputs disposed in a cross pattern.

15. (Original) The apparatus according to claim 12, wherein the multifunction switch comprises a plurality of discrete inputs disposed in a circular pattern.

16. (Original) The apparatus according to claim 12, wherein the multifunction switch comprises a plurality of discrete inputs disposed in a star pattern.

17. (Canceled)

18. (Previously Presented) A method for interfacing a user and a computer program comprising:

coupling a joystick to a computer interface to provide first input from a user to a computer program executing on a computer;

coupling a joy pad to a computer interface to provide second input from a user to the computer program executing on the computer; and

disposing the joystick in close proximity to the joy pad so that a single user's digit can manipulate both the joystick and one or more buttons or positions on the joy pad,

wherein the joystick includes a knob disposed on a top of the joystick, said knob having a circular top and extending in radius to the plurality of directional inputs.

19. (Original) The method according to claim 18, further comprising:

performing predetermined operations in the computer program from a combination of inputs from both the joystick and the joy pad.

20. (Original) The method according to claim 18, wherein the joystick is disposed in a center of the joy pad.

21. (Original) The method according to claim 18, wherein the joy pad includes a plurality of inputs disposed in a cross pattern.

22. (Original) The method according to claim 18, wherein the joy pad comprises a plurality of inputs disposed in a circular pattern.

23. (Original) The method according to claim 18, wherein the joy pad comprises a plurality of inputs disposed in a star pattern.

24. (Canceled)

25. (Previously Presented) The method according to claim 18, wherein the knob includes a beveled edge.

26. (Original) The method according to claim 18, wherein the joy pad includes a touch pad.

27. (Canceled)

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.